

## REMARKS

### Status of the claim

Claim 1 is presently pending in the application and has been amended as shown above. Support for the amendment is found, for example, at page 23, line 21 through page 27, line 6 of the specification.

### Specification

The specification has been amended, as shown above, to correct an inadvertent typographical error in the Serial Number of a priority application. Applicants will submit, under separate cover, a substitute declaration listing the correct priority application.

### Priority

The present application claims priority to USSN 09/535,088 filed on March 23, 2000. Due to a typographical error, the specification and declaration listed USSN 09/535,008 as the priority application. Applicants have, by amendment herein, listed the correct Serial Number. In support of this correction, Applicants note that USSN 09/535,088 claims the benefit of provisional applications 60/126,238; 60/126,239; 60/146,595 and 60/146,615, all of which were listed in the specification and declaration as priority applications. By contrast, USSN 09/535,008 does not claim benefit of any of these four provisional applications, is in a completely different art and has different inventors.<sup>1</sup> Accordingly, it is clear that the 09/535,008 was listed in error and that 09/535,088 is the correct priority application.

### Inventorship

A request to correct inventorship to join Edward Rebar and Andrew Jamieson, a Statement from Persons to be Added as Inventors and a Consent of Assignee to Correct

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<sup>1</sup> See the front page of U.S. Patent No. 6,465,629 (attached) which was issued from USSN 09/353,008

Inventorship were mailed to the Office on February 17, 2004. Applicants request confirmation of the correction of inventorship.

**35 U.S.C. § 112, second paragraph**

Claim 1 stands rejected as indefinite for allegedly failing to recite active method steps. *Office Action*, paragraph 5. As amended, claim 1 recites a series of method steps for the preparation of a zinc finger protein. Accordingly, this rejection can be withdrawn.

**35 U.S.C. § 103(a)**

Claim 1 stands rejected as allegedly obvious over U.S. Patent No. 6,453,242 (Eisenberg) in view of U.S. Patent No. 6,140,081 (Barbas) and U.S. Patent No. 6,503,717 (Case). The references are applied by virtue of their 35 U.S.C. § 102(e) dates. *Office Action*, paragraph 8.

In response, Applicants note that the primary reference (Eisenberg) is assigned to Sangamo BioSciences, Inc. as recorded in the USPTO on January 2, 2001 at Reel 011246, Frame 0574. The secondary Case reference is also assigned to Sangamo BioSciences, Inc. as recorded in the USPTO on April 10, 2001 at Reel 011471, Frame 0650. Moreover, at the time the presently-claimed invention was made, it was under an obligation of assignment to Sangamo BioSciences, Inc.<sup>2</sup> Thus, in accordance with 35 U.S.C. § 103(c), neither Eisenberg nor Case are available as references under 35 U.S.C. § 103(a).

The remaining reference (Barbas) fails to disclose or suggest position-dependence of recognition of triplet sequences by zinc fingers in a multi-finger protein, and therefore fails to render the pending claim obvious. Accordingly, this rejection should be withdrawn.<sup>3</sup>

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<sup>2</sup> Said obligation fulfilled by assignment of the present application to Sangamo BioSciences, Inc. (recorded in the USPTO at Reel 012363, Frame 0236 and at Reel 014348, Frame 0420) and assignment of parent application USSN 09/535,088 (recorded in the USPTO at Reel 011464, Frame 0341).

<sup>3</sup> See also Applicants' Responses dated February 19, 2004 and February 26, 2004.

Claim 1 also stands rejected under this section over Eisenberg *et al* (WO 00/42219, published July 20, 2000) in view of Barbas (U.S. Patent No. 6,140,081, issued October 31, 2000) and Case *et al.* (WO 01/40798, published June 7, 2001). Eisenberg and Barbas are applied under 35 U.S.C. § 102(b), while Case is applied under 35 U.S.C. § 102(a) and 35 U.S.C. § 102(e). *Office Action*, paragraph 9.

In response, Applicants direct attention to parent application Serial No. 09/535,088 ('088) filed on March 23, 2000. The '088 application discloses the F1 sequence QRSNLVR binding to GAA at position S1. See, for example, Table 1 at page 22 (SBS #s 374 and 427). The '088 application also discloses the F2 sequence QSGNLAR binding to GAA at position S2. See, for example, Table 4 at page 37 (SBS#746). The '088 application also discloses the F3 sequence QSGNLAR binding to GAA at position S3. See, for example, Table 5 at page 47 (SBS#s 1227, 1237) page 48 (SBS#1250) page 51 (SBS#s 1395, 1396, 1397) page 52 (SBS#1406) and page 53 (SBS#s 1479, 1480 and 1484).

Neither Eisenberg (published July 20, 2000) nor Barbas (issued October 31, 2000), both of which were cited under 35 U.S.C. § 102(b), were published more than one year before March 23, 2000 and accordingly are unavailable as references. Case (published June 7, 2001) is not available as a 102(a) reference against the March 23, 2000 disclosure of the claimed subject matter. Moreover, Case fails to disclose or suggest position-dependence of recognition of triplet sequences by zinc fingers in a multi-finger protein, and therefore fails to render the pending claim obvious. Accordingly, this rejection should be withdrawn.

**CONCLUSION**

Applicants believe that the claim is in condition for allowance and look forward to notification to that effect. The Examiner is invited to telephone the undersigned if she believes it would assist in the prosecution of this application.

Respectfully submitted,

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By: Sean Brennan

Sean M. Brennan  
Registration No. 39,917

Sangamo BioSciences, Inc.  
501 Canal Blvd., Suite A100  
Richmond, California 94804

Telephone: (510) 970-6000 ext. 252  
Facsimile: (510) 236-8951